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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,565	09/15/1999	JIN LU	PHA-23.775	7621
24737	7590	10/12/2006	EXAMINER MAHMOUDI, HASSAN	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			ART UNIT 2165	

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/396,565

**Applicant(s)**

LU, JIN

**Examiner**

Tony Mahmoudi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission and its accompanying Amendment filed on 15-May-2006 have been entered.

### ***Remarks***

2. In view of the Amendment filed on 15-May-2006, claim 25 is cancelled and claims 1-10, 12-21, and 23-24 are amended per applicant's request. Therefore, claims 1-24 are presently pending in the application, of which, claims 1, 12, 23, and 24 are presented in independent form.

### ***Specifications***

3. The disclosure is objected to because it contains embedded hyperlinks and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The specification contains multiple references to hyperlinks and/or other form of browser-executable code. Examples of these hyperlinks are visible in lines 15 and 20 of page 17 of the originally filed specifications. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Amended independent claims 1, 12, 23, and 24 (and their dependent claims, where applicable) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I) Independent claim 1, as amended by the Applicant, recites the limitation, “**An apparatus for use with a host device having a receptacle**”, which renders the claim indefinite. It is not clear from the claim language as to whether the “receptacle” is located within the apparatus itself, or within the host device. The Applicant can overcome this rejection by amending claim 1 to specify where the receptacle is located (e.g., amend the claim preamble to state, “An apparatus for use with a host device, the host device having a receptacle”, or amend the claim to insert the recently removed limitation of “of the host device” following the word “receptacle” in line 3 of the claim, so that it reads, “.... into the receptacle of the host device,....”).

II) Independent claim 23 recites the limitation, **“such that the agent program runs on a second processor of the host device and controls....”**, which renders the claim indefinite. It is not clear from the above recitation, whether the host device has multiple (more than one) processors or it has only one processor, being “a second processor” of the claimed invention. The Applicant can overcome this rejection by amending the above recitation to state, **“such that the agent program runs on a second processor, the second processor included in the host device, and controls....”**.

III) Independent claims 1, 12, 23, and 24 each recite the limitation:

**“the second processor receiving a message from the first processor, the message identifying the agent program to be downloaded, and in response to the message the second processor downloading the agent program from the removable card via a data channel created between the removable card and the host device.”**

In each of the independent claims, the above limitations appear *immediately following* the result step of “controlling communication between the first application and the second application” (without any indentation or clear separation from the result step), insinuating that the above limitations are meant to further define what the result (“controlling of communication”) represents or achieves.

However, the Examiner interprets the above limitations as the steps leading to the “downloading of the agent program from the removable card to the host device” (and not as steps or processes defining the results of “controlling communication”). As such, the

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Examiner requests that the claims be amended to recite the steps/elements of the claims in the order in which they take place, or clearly indicate that the above recitation defines the process/steps required for the downloading of the agent application from the removable card to the host device.

The Applicant can overcome this rejection by amending each of the independent claims to recite the following proposed example:

**“wherein the downloading of the agent program comprises the second processor receiving a message from the first processor, the message identifying the agent program to be downloaded, and in response to the message the second processor downloading the agent program from the removable card via a data channel created between the removable card and the host device.”**

IV) The independent claims of the instant application recite several limitations following the terms “*adaptable*” and “*for*”, as follows:

Claim 1 recites, “a removable card *adaptable for* insertion into the receptacle”; and, “including a first processor *for* running a first application”,

Claim 12 recites, “*adapting* a removable card *for* insertion into the receptacle....”; and, “including a first processor *for* running a first application”,

Claim 23 recites, “a removable card *adaptable for* insertion into a receptacle....”; and, “a first processor *for* running a first application”, and

Claim 24 recites, “a first processor for running a first application”; “a host device having a receptacle adaptable to receive the removable card”; and, “a second processor for running a second application”.

Any function or limitation following the terms “*adaptable*” and “*for*” merely hint of a system “*ability*” and “*intended use*” respectively, and does not indicate that the recited limitation followed by such terms is necessarily a required function/element of the claimed invention. Therefore, these recitations render the above claims indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cannot clearly establish whether the functions of “inserting the removable card”, “running of a first and a second application”, and “receiving the removable card” are indeed required functionality of the claims.

In particular, the function/step of “inserting the removable card into the receptacle” is considered an essential element of the invention, without which, the agent program cannot be downloaded from the removable card into the host device and without which, there will be no communication between the first and the second application. The Applicant is required amend the claims to recite the “insertion” and other limitations noted above in a *definite* form, *examples for which* are suggested below:

Claim 1 to be amended to recite, “a removable card ~~adaptable for insertion~~ inserted into the receptacle”; and, “including a first processor ~~for running~~ which runs a first application”,

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Claim 12 to be amended to recite, “~~adapting~~ a removable card ~~for insertion~~ inserted into the receptacle....”; and, “including a first processor ~~for running~~ which runs a first application”,

Claim 23 to be amended to recite, “a removable card ~~adaptable for insertion~~ inserted into a receptacle....”; and, “a first processor ~~for running~~ which runs a first application”, and

Claim 24 to be amended to recite, “a first processor ~~for running~~ which runs a first application”; “a host device having a receptacle ~~adaptable to receive~~ which receives the removable card”; and, “a second processor ~~for running~~ which runs a second application”.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Amended independent claims 1, 12, 23, and 24 (and their dependent claims, where applicable) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 1, 12, 23 and 24, as amended by the Applicant, produce a result indicated as, “the agent program runs on the second processor and controls communication between the first application and a second application”. The produced result is neither considered *tangible*, nor *useful*.



There is no indication to the user as to what is to be expected as a result of this “communication control”, and no indication for the user to know if the results are ever achieved. The end results of these claims are not communicated to the user and the process of “controlling the communication” appears to be transparent to the user. Therefore, in the event that a user inserts his memory card (card with a processor) into the receptacle of the host device (host reader/processor), the user, based on the limitations recited in the referenced claims, has no idea of what, if anything, is being processed or what he/she would expect as a result of said “controlled communication by the agent program”. Therefore the produced result is not considered *tangible*.

The Applicant can overcome this rejection by amending the claim to recite, for example, a limitation that would indicate to the user that the communication between the two applications is being controlled by the agent program; or in another example, recite a limitation indicating what the user would expect as a result of said communication being controlled by the agent program.

The above examples are strictly meant to serve as suggestions to the Applicant. Any amendments made to the claims must be adequately supported by the originally filed specification of the instant application, to avoid introduction of “new matter”.

Furthermore, the independent claims neither identify the environment (industry) in which this invention is used, nor do they clearly establish what could be expected or gained as the end results of “controlling the communication between the first and second application by the downloaded agent program”. In other words, there is no indication of where this invention is

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used and how one would benefit from its results. Therefore, the results are not considered *useful*. The Applicant can overcome this rejection by:

amending the preamble *of each independent claim*, to indicate what (environment or industry) the invention is used for. For example,

“An apparatus (or a method, or an article of manufacturer, or a system) for use ~~with a~~ providing interaction between a removable card and a multimedia host device having a receptacle, the apparatus (or a method, or an article of manufacturer, or a system) comprising:”

*and*

by amending *each of the independent claims* to clearly identify what the end result of “controlling communication” provides. For example,

“....., such that the agent program runs on the second processor and controls communication between the first application and a second application running on the second processor, providing a user of the removable card, one or more multimedia programs from the host device.”

The above examples are strictly meant to serve as suggestions to the Applicant. Any amendments made to the claims must be adequately supported by the originally filed specification of the instant application, to avoid introduction of “new matter”.

***Allowable Subject Matter***

8. Independent claims 1, 12, 23 and 24 of the instant Application contain subject matter, which is not taught or suggested by the cited prior art made of record (reasons provided below).

However, since at the present time the above claims remain rejected under the second paragraph of 35 U.S.C. 112 and/or under 35 U.S.C. 101, the Examiner is deferring any decision for indication of allowability of the instant Application until after all rejections provided in this Office Action are fully overcome by the Applicant.

Any amendments made to the claims to overcome the above rejections must be fully supported by the originally filed specification of the instant Application (ensuring enablement and avoiding introduction of "new matter"), and must not result in broadening the scope of the claims and/or or the invention as a whole.

Introduction of any of "new matter" or "enablement" issues, or any broadening of the scope of the claimed invention will result in a new search and would require further consideration, including possible new grounds for rejection over the prior art (to be) identified as the result of the required search.

9. The following is a statement of reasons for the indication of allowable subject matter:

Applicant's amendments (filed on 15-May-2006) made to the independent claims, include *Allowable Subject Matter* of the dependent claims, as indicated by the Examiner in the previous Office Action.

The prior art made of record do not teach or suggest the process of “downloading the agent program from the removable card to the host device” requiring/comprising “the second processor receiving a message from the first processor, the message identifying the agent program” (from among the plurality of agent programs residing on the removable card) “to be downloaded, and in response to the message the second processor downloading the agent program from the removable card via a data channel created between the removable card and the host device”, as recited in the amended independent claims 1, 12, 23, and 24.

### ***Response to Arguments***

10. Applicant's arguments filed on 15-May-2006 with respect to rejection of the amended claims in view of the cited prior art made of record have been fully considered but they are moot in view of the new grounds for rejection and in view of the indication of Allowable Subject Matter by the Examiner in this Office Action.

### ***Conclusion***

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.



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